

REMARKS

By the present amendment, new claims 25-32 have been added. Support for new claims 25-28 is found in original claim 1 and on page 1, lines 26-27, page 2, lines 33-34 and page 3, lines 3-5. Support for new claim 29 is found in original claims 1 and 6. Support for new claims 30-32 is found in the original application, in particular on page 3, lines 14-16 and the Examples.

Claims 1-32 are pending in the present application. Independent claim 1, and claims 2-11, 20-23, and 30 dependent directly or indirectly on claim 1, are directed to a polarizing plate. Independent claim 12 is directed to a liquid crystal display. Independent claims 13 and 24, and claims 14-19 dependent directly or indirectly on claim 13, are directed to a method of producing a polarizing plate. Independent claims 25, claims 26-28 and 31 dependent thereon, and independent claim 29 and claim 32 dependent thereon, are directed to a polarizing plate.

As a preliminary, Applicants and Applicants' representative thank the Examiner and his Supervisor for the personal interview of July 27, 2004.

In the Office Action, claims 1-5, 8-11 and 20-23 are rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. It is alleged in the Office Action that these claims "lack positive and specific structural limitations." Reference was made in the Office Action and during the interview to "single means" claims as defined in MPEP 2164.08(a).

The rejection is again respectfully traversed. It is submitted that the optical properties recited in the present claims are not just results to be achieved but are "positive and specific structural limitations" that properly define the presently claimed invention in the optical field, more specifically, the field of polarizing elements.

Reference is made in particular to the passage on page 1, lines 15-20 of the present

specification, which explains that a technical problem faced in the prior art was the color or contrast irregularity in a display such as an LCD monitor for a personal computer. A contribution to the art by the present inventors was to link these display irregularities in a monitor, first, specifically to the polarizing plate present in the display, and second, specifically to the ratios of single transmittance to crossed transmittance in the polarizing plate.

More specifically, color display panels may include color filters of blue, green and red, with central wavelengths of generally 440 nm for blue, 550 nm for green, and 610 nm for red. Since optical dropout is increased unless crossed transmittance of the display is lowered, it might have occurred to a person of the art, *arguendo*, that display irregularity of a display was related to the crossed transmittance of the display as a whole, and it might have been expected, still *arguendo*, that the crossed transmittance would be lowered when the single transmittance in visibility compensation (700-400 nm; every 10 nm) of the display is low, which would make display irregularity difficult to perceive visually. However, the prior art had never focused on the polarizing plate as a problem in relation with color irregularity.

In contrast, the present inventors have identified that color irregularity in a display is related to the ratio of single transmittance to crossed transmittance in the three main central wavelengths in a polarizing plate when used in the display. Thus, a polarizing plate that satisfies the relationships recited in present claim 1 is regarded as a polarizing plate for which color irregularity can be ignored, and thus, the problem of color irregularity in the display can be solved.

Further, regarding the reference in the Office Action to the prohibition of “single means” claims and the citation of the Federal Circuit decision In re Hyatt, 708 F2d. 712, 218 U.S.P.Q. 195 (Fed. Cir. 1983), it is submitted that the qualification of any of the present claims as a “single

means” claim is inaccurate, because these claims are completely different from “single means” claims as defined in the Hyatt case and in MPEP 2164.08(a). Specifically, the claim at issue in Hyatt was as follows:

35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals.

Hyatt at 713 (emphasis added). The Court identified the claim as a “single means” claim in the following terms:

To set forth at the outset what should be apparent, claim 35 is a single means claim. It is not disputed that it is drafted in means-plus-function format, and it is not disputable that it is drawn to a single element.

Hyatt at 714 (emphasis added). Thus, under Hyatt, a “single means” claim is defined as a “means-plus-function” claim that is the only element in the body of a claim. It is noted that the MPEP has adopted the same definition: “A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means...” (MPEP 2164.08(a)) (emphasis added.)

Finally, the Court explained the lack of enablement inherent in a “single means” claim as follows:

The long-recognized problem with a single means claim is that it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor.

Id. (emphasis added, citations omitted). In other words, the problem inherent in a “single means” claim is that the “means-plus-function” element is not limited to the means disclosed in the

specification.

In contrast, the present claims are not “means-plus-function” claims, and they recite a plurality of elements which form a combination of concrete and measurable properties, so that they are greatly different from the type of “single means” claims envisioned in Hyatt and MPEP 2164.08(a). In other words, the optical transmittance ratios recited in the present claims are not a “single means” recitation, but the recitation of a combination of definite, concrete, and easily measurable structural properties of a polarizing plate that make it possible to reduce color irregularity when the polarizing plate used in a display. These features of the presently claimed polarizing plate are illustrated and exemplified at length in the present specification so as to enable a person of ordinary skill in the art to practice the full scope of the invention as defined in the present claims.

In addition, it is noted that Applicants are not required to disclose all the processes available to obtain a polarizing plate having the claimed features. The Manual of Patent Examining Procedure (MPEP) states:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987).

MPEP 2164.01(b). Here, the examples provided in the specification provide more than a reasonable correlation with the entire scope of the claims because several examples of samples having the features recited in the present claims are disclosed, as well as several comparative

examples (see Tables 1-3 on pages 11-12 of the present specification), followed by a thorough evaluation of their effectiveness in relation with color irregularity in a display (see Table 4 on page 12 of the present specification).

In particular, it is submitted that the enablement issue with respect to the present claims should be considered in light of the fact that the optical field is a predictable field, so that the extent of the disclosure in the present specification is sufficient to enable a person of ordinary skill to practice the claimed invention without undue experimentation. See MPEP 2164.03. In the present case, once the optical properties are defined and illustrated as in the present specification, a person of ordinary skill in the art would be able to adapt or extrapolate the manufacturing conditions to obtain a polarizing plate having the required properties, based on the predictable optics rules for various materials and constructions.

In summary, a person of ordinary skill in the art would find sufficient guidance to obtain a polarizing plate having the combination of features recited in the present claims. The existence or not of alternative methods to obtain the same polarizing plate is irrelevant to the enablement inquiry under 35 U.S.C. 112, first paragraph.

In addition, with respect to present claims 25-28, it is submitted that obtaining a polarizing film by dyeing and crosslinking, as well as stretching (claim 26), is a typical process, as discussed in the present specification (see, e.g., the paragraph bridging pages 2-3). Thus, a person of ordinary skill in the art, based on the present specification, would understand in particular a relationship between the ratios of single transmittance to crossed transmittance as recited in present claim 25, a reduction in dye irregularity in the polarizing plate, and a reduction in color irregularity in a display in which the polarizing plate is used. Therefore, for this reason alone,

present claims 25-28 are fully enabled by the disclosure in the present specification.

In view of the above, it is submitted that the rejection should be withdrawn.

Next, in the Office Action, claims 1-5 and 20-23 are rejected under 35 U.S.C. 102(b) as anticipated by US 5,071,906 to Tanaka et al. (Tanaka), claims 6-7, 14-19 and 24 are rejected under 35 U.S.C. 103(a) as obvious over Tanaka, claims 8-11 are rejected under 35 U.S.C. 103(a) as obvious over Tanaka in view of US 5,833,878 to Shinohara et al. (Shinohara), and claim 12 is rejected under 35 U.S.C. 103(a) as obvious over Shinohara in view of Tanaka.

It is alleged in the Office Action that the polarizing film of Tanaka inherently exhibits the transmission properties as recited in the present claims. With respect to the producing method, it is acknowledged in the Office Action that Tanaka does not recite more than one crosslinking bath - stretching operation, but it is alleged that, since Tanaka proposes various conditions for the crosslinking bath - stretching operation, it would have been obvious to subject a polarizing film to two successive treatments.

The rejections are again respectfully traversed. As acknowledged in the Office Action, Tanaka does not suggest two successive crosslinking bath - stretching operations, and further, Tanaka suggests varying the operation conditions instead of repeating the operation, so that a person of ordinary skill in the art would not be motivated to repeat the crosslinking bath-stretching operation. Moreover, even if one attempted to repeat the crosslinking bath-stretching operation, Tanaka would not provide any teaching as to the conditions for the second operation. Therefore, the process of Tanaka is similar to the processes illustrated in Comparative Examples 1 and 2, which show that a single crosslinking bath-stretching operation is insufficient to obtain the properties recited in the present claims (Comp. Ex. 1), and that an inappropriate relation between

the stretch ratios in the first and second operations results in insufficient properties (Comp. Ex. 2).

In contrast, the present inventors have established a connection between the conditions of a second stretching operation on a film and resulting optical properties for a polarizing plate in the context of the present invention. The criticality of the second crosslinking bath-stretching operation in the embodiment of the inventive process illustrated in the Examples is shown by the Comparative Examples.

In summary, the features of the presently claimed process, and the features of the presently claimed polarizing plate and display, are not taught or suggested in Tanaka, and the other cited references fail to remedy the deficiencies of Tanaka. Therefore, the present claims are not obvious over Tanaka or any cited combination of references including Tanaka.

In view of the above, it is submitted that the rejections should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

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In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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